

Docket No.: 00-VE14.10
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dale L. Bartholomew et al.

Confirmation No.: 5034

Application No.: 09/144,635

Art Unit: 2616

Filed: August 31, 1998

Examiner: C. Y. Ng

For: SELECTIVE BANDWIDTH CONNECTIVITY
THROUGH NETWORK LINE CARDS

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is filed in response to the Notification of Non-Complaint Appeal Brief mailed December 19, 2007 ("Notice") to supplement the Amended Appeal Brief filed December 6, 2007. In this appeal Applicants (hereinafter "Appellants") appeal the decision of the primary Examiner in the Office Action dated June 14, 2007 ("Final Office Action"). This paper is being filed in lieu of a further Amended Appeal Brief pursuant to the Office's instruction in the Notice that "the entire brief is not required, only the section that was found."

Appellants disagree that the Amended Appeal Brief did not comply with 37 C.F.R. § 41.37(c)(1)(vii). In the Amended Appeal Brief, "each ground of rejection" was "treated under a separate heading." However, Appellants hereby submit this response, in which the heading of Section A of the Arguments section has been amended in a fashion that is believed to address the Office's concern as set forth in the Notice.

Please accept the following as a replacement to section VII. **ARGUMENT** in the Appeal Brief:

A. Grounds of Rejection 1-3: The Law Regarding the Rejections of Claims 1-61

With respect to Section 102 rejections, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *E.g., Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). *See also* M.P.E.P. § 2131.

With respect to Section 103 rejections, the Examiner has a burden of stating a prima facie case of obviousness. A prima facie case of obviousness has historically required that:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP, § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

So long as the first requirement for a prima facie case of obviousness is not rigidly applied, requiring the Examiner to show some reason for combining prior art references is consistent with the United States Supreme Court’s recent decision in *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). In *KSR*, the Supreme Court stated that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” (*Id.* at 1739, 82 USPQ2d at 1395.) Additionally the court stated that

It can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

(*Id.* at 1741, 82 USPQ2d at 1396.) The Court further explained that

What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under §103. One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

(*Id.* at 1742, 82 USPQ2d at 1397.) Accordingly, the Court made clear that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” (*Id.* at 1731, 82 USPQ2d at 1389.) In summary, KSR plainly does not disturb the well-settled proposition that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P § 2141.02.

B. Ground of Rejection No. 1.

1. Independent Claims 1, 18, 25, 27, 37, 41, 46, 48, 53, 54, 56, and 59 are not anticipated by Czerwiec and all of Appellants' claims are therefore patentable.

Czerwiec does not teach or suggest a “monitor,” as is recited by each of Appellants' independent claims. Independent claim 1, discussed in this Section B1 as representative of all of Appellants' independent claims, recites, among other elements, “detecting, via a monitor, that the requesting step does not seek conversion in said line unit.” The Examiner asserted that the recited monitor is anticipated by Czerwiec based on the Examiner's allegation that “junction 66 in Fig. 2 decides whether the request is passed to low pass filter 40 or high pass filter 38.” (Office Action, page 2.) However, Czerwiec in reality does not include any decision-making point as alleged by the Examiner. Czerwiec in fact teaches no more than the use of “frequency division multiplexing, i.e., joining the POTS service on the line 50 at a low frequency with the high-bandwidth services provided on the line 58.” (Czerwiec, 11: 23-26.) Czerwiec does not teach or suggest “monitoring” or a “monitor” at all.

Specifically, Czerwiec discloses at most an Asymmetric Digital Subscriber Line (ASDL) shelf 34 that includes high pass filter 38, a low pass filter 40, a network termination (NT) card 60, and a line termination (LT) card 62. (E.g., Czerwiec, Figure 2.) However, Czerwiec does not teach or suggest a monitor integrated with a line unit/card. (See

Applicants' Specification, Figure 3, especially elements 21 and 22; page 15, line 20 – page 19, line 3.) In particular, Czerwiec's junction node 66 does not in any way teach or suggest the "monitor" recited in Applicant's claims.

In fact, Czerwiec discloses nothing more than combining filtered signals, and does not teach or suggest "monitoring" at all. Czerwiec clearly states that

The ATM switch 48 provides ATM formatted data on a line 58 to a network termination (NT) card 60 which is, in turn, connected to a plurality of ADSL-line termination (LT) cards such as the card 62 which includes the highpass filter 38 for providing the ADSL signal on a line 64 to a junction node 66 for combination with the normal telephony signals provided by the lowpass filter 40. The node 66 thus forms a means for frequency division multiplexing, i.e., joining the POTS service on the line 50 at a low frequency with the high bandwidth services provided on the line 58 and converted to ADSL by the LT 62 at a higher frequency for passing through the filter 38 and on to the line 64 for combination with the telephony service at the node 66 of the twisted copper pair 36.

(Czerwiec, 11: 15-29; emphasis added.) In other words, Czerwiec's junction node 66 is not a monitoring or decision point of any kind, but rather is a point at which signals from a low pass filter are combined with signals from a high pass filter. A junction node is plainly not a "monitor," and therefore Czerwiec does not anticipate Applicants' claims.

The present Section 102 rejection of Appellants' claims should be reversed for at least this reason. Further, for at least the reasons stated in this Section, all of Appellants' independent claims, and therefore all of Appellants' claims, are patentable over Czerwiec.

2. Independent Claims 1 and 54: "detecting . . . that the requesting step does not seek conversion in said line unit"

Claims 1 and 54 each recite "detecting, via a monitor, that the requesting step does not seek conversion in said line unit." As noted above, Czerwiec does not teach or suggest the recited monitor in any way at all. Further, Czerwiec does not teach or suggest any "detecting . . . that the requesting step does not seek conversion in said line unit." Therefore, the rejection of claims 1 and 54 should be reversed for this additional reason.

The Examiner alleged that Czerwiec's disclosure of subscriber equipment including a "lowpass filter . . . responsive to a telephony signal occupying a baseband position in a frequency division multiplex signal also having a wideband signal occupying a position above

baseband” reads on the recitation “that the requesting step does not seek conversion in said line unit.” (Final Office Action, page 2; citing Czerwiec, 4: 37-50.) In fact, Czerwiec plainly does not teach or suggest any “detecting” related to whether a request does or does not “seek conversion in said line unit.” In fact, Czerwiec does not appear to include any teaching or suggestion relating to “conversion” at all. At most, Czerwiec teaches filtering a signal to obtain a portion of the signal for use in voice communications (Czerwiec, 4: 43-46), and further providing “a digital line subscriber modem . . . for providing [the] wideband” portion of the frequency division multiplex signal. (Czerwiec, 4: 48.50.) In other words, Czerwiec teaches at most filtering a signal and does not include any teaching or suggestion of detecting that a request does or does not “seek conversion in said line unit.”

In sum, Czerwiec does not include any teaching or suggestion relating to “conversion in said the wine unit,” much less “detecting . . . that the requesting step does not seek conversion in said line unit.” Therefore, for at least this further reason, the rejection of claims 1, 53, and 54, as well as claims 2-17 depending from claim 1, and claim 55 depending from claim 54, should be reversed.

3. Independent Claim 18: “detecting . . . that the request seeks bandwidth in excess of that available through said line unit”

Claim 18 recites “detecting, via a monitor, that the request seeks bandwidth in excess of that available through said line unit.” As noted above, Czerwiec does not teach or suggest the recited monitor in any way at all. Further, Czerwiec does not teach or suggest any “detecting . . . that the request seeks bandwidth in excess of that available through said line unit.” In fact, Czerwiec does not appear to include any teaching or suggestion at all concerning monitoring a volume of bandwidth. Therefore, the rejection of claims 1, 53, and 54 should be reversed for this additional reason.

The Examiner cited the portion of Czerwiec discussed above with respect to claims 1, 53, and 54 with respect to the recitation in claim 18 of “detecting . . . that the request seeks bandwidth in excess of that available through said line unit.” As noted above, Czerwiec teaches at most filtering a signal to identify voice communications and digital communications, but does not in any way teach or suggest the recited “monitor.” Such disclosure does not in any way teach or suggest monitoring, much less monitoring a volume

of bandwidth or detecting that a “request seeks bandwidth in excess of” a given amount of bandwidth, much less, “bandwidth in excess of that available through said line unit.”

For at least these further reasons, claim 18, as well as claims 19-26 depending therefrom, are patentable over Czerwiec. Therefore, the rejection of these claims should be reversed at least for these further reasons.

B. Ground of Rejection No. 2: Claims 14 and 53 are not obvious over Czerwiec and allegedly admitted prior art.

Independent claim 53, like independent claim 1, recites “detecting, via a monitor, that the requesting step does not seek conversion in said line unit. Accordingly, claim 53 is patentable over Czerwiec alone or in combination with any other prior art for any of the independent reasons set forth above regarding claim 1.

Further, claim 14 (which depends from claim 1 and is patentable for at least that reason) and claim 53 each recite “signaling a central processing unit (CPU) controlling said telephone network switch to effect an entry in a journal of said telephone network switch, and using said entry for billing for the communications path set up in response to said requesting step.” The Examiner acknowledged that Czerwiec does not disclose this recitation. However, to compensate for the acknowledged deficiencies of Czerwiec, the Examiner asserted that

Eitel discloses that when a call request is first received by a local telephone switch by the calling party, a billing file is created based upon factors such as the service rate of the calling party, the identity of the called party, time of day, etc. [Once] the billing file is created, a controller of the local switch can determine how to establish the connection to the called party. Refer to Column 1, lines 43-60.

(Final Office Action, page 6.) However, assuming arguendo that the Examiner correctly characterized Eitel, simply having a controller determine how to establish a connection after a billing file is created does not read on claims 14 and 53, which require “using said entry for billing for the communications path set up in response to said requesting step.”

In fact, Eitel teaches away from the foregoing recitation of claims 14 and 53 because Eitel teaches that, after “a billing file is created, a controller . . . may determine how to establish a connection with the called party” by referring not to the billing file, but by referring “to the called number.” (Eitel, 1: 56-59.) Thus, one of ordinary skill in the art, upon reading Eitel, would have seen no reason for “using said entry for billing for the

communications path set up in response to said requesting step” because Eitel teaches establishing a connection by referring to a call number. At a minimum, Eitel includes no teaching or suggestion of using a billing entry “for the communications path set up in response to said requesting step” as recited by each of claims 14 and 53.

Accordingly, claim 14 is separately patentable at least for the foregoing reasons. Further, the foregoing reasons provide further independent support for the patentability of claim 53. Therefore, the rejections of each of claims 14 and 53 should be reversed.

C. Ground of Rejection No. 3: Claims 36, 41-45, 47, 48, and 56-58 are not obvious over Czerwiec and Horiki.

Independent claims 41, 48, and 56 are patentable over the combination of Czerwiec and any other prior art reference at least for the reasons stated above with respect to claim 1. Further, dependent claims 36, 42-45, 47, and 57-58 are patentable over the alleged combination of Czerwiec and Horiki at least by reason of these claims’ dependence from patentable independent claims, as stated above. Accordingly, the rejections of these claims should be reversed for at least these reasons.

Further, claim 41 recites “a converter for converting signals on the plurality of local links to digital signals at a predetermined narrowband bit-rate.” The Examiner acknowledged that Czerwiec does not disclose this recitation. However, the Examiner cited Horiki as allegedly compensating for the acknowledged deficiencies of Czerwiec. According to the Examiner, Horiki discloses that “ordinary voice switching is sent on to a narrowband digital rate channel of a predetermined data rate of 8 kHz PCM.” (Final Office Action, page 9.) However, it is unclear what the Examiner is referring to by “a predetermined data rate of 8 kHz PCM” and therefore the Examiner’s rejection should be reversed for at least this reason. The term “PCM” in Horiki plainly refers to “pulse code modulation,” which, as described in Horiki’s Abstract, involves sampling an analog signal “at a high rate,” thereby producing “a high-speed sampling digital code.” Thus, mere use of PCM does not teach or suggest converting signals . . . at a predetermined narrowband bit-rate.” Because Horiki does not appear to teach or suggest “converting signals . . . at a predetermined narrowband bit-rate,” the rejection of claim 41 should be reversed for at least this further reason.

CONCLUSION

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under Order No. 65632-0140, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Respectfully submitted,

Dated: January 17, 2008

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